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EXAMINER

DESANTO, MATTHEW F

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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/839,065
Filing Date: April 20, 2001
Appellant(s): YE ET AL.

David Crompton
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 04/09/08.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences, which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct and the petition decision filed on 02/15/08 dismissed the petition filed on 4/27/04.

(5) *Summary of Claimed Subject Matter*

The summary of invention contained in the brief is correct.

(6) *Grounds of Rejection to be Reviewed on Appeal*

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) *Claims Appendix*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) *Evidence Relied Upon*

6,090,099	Samson et al.	7-2000
5,951,539	Nita et al.	9-1999

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 41 are rejected under 35 U.S.C. 102(e) as being anticipated by Samson et al. This rejection is set forth in a prior Office Action, mailed on 1/28/04 and 8/12/03.

Claims 1, 3-6, 8-11, 13, 14, 15, 17, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Samson et al. This rejection is set forth in a prior Office Action, mailed on 1/28/04 and 8/12/03.

Claims 1, 3-34, and 41 are rejected under 35 U.S.C. 103(a) Nita et al. (USPN 5,591,539). This rejection is set forth in a prior Office Action, mailed on 1/28/04 and 8/12/03.

(10) *Response to Argument*

The applicant argues that the examiner has interpreted “shapeable by thermoforming techniques” as a product by process claim recitation. This is not true. The examiner is interpreting that statement as a product by process limitation and has given that limitation the full scope as suggested by the MPEP, in sections 2112.01, 2112.02, and 2113.

The applicant then points out section 2173.05(p)(I) of the MPEP to show that claim 1 is not a product by process claim. This statement is irrelevant, because the examiner understands that a patent can be given for a process. This section of the MPEP does not given any insight into how to interpret claims that have process

limitations in an apparatus claim. Sections 2112.01, 2112.02, and 2113 of the MPEP are the areas that cover the interpretation of these claims.

The applicant next states that the tip is “shapeable” and this term shapeable gives structure to the claim. The examiner once again disagrees with the applicant, with respect to the structure given to the tip. The examiner does not understand what structure is being given or claimed, by the term shapeable. The examiner agrees that the term shapeable means that the tip has the ability to be shaped, which is what the prior art reference discloses throughout the background and specification (see Samson, Column 1, lines 20-25). The examiner also described his interpretation of claim 1 on page 5 and 6 of the office action dated 2/25/03 with regards to the term shapeable. The examiner would further like to add that the term shapeable is functional language and the prior art only has to be capable of performing the function as described in the claim (MPEP section 2114). This concept can be seen in Samson in Column 5, lines 10-15, because Samson states that the catheter will be used in the neurological and peripheral vascular system and therefore must change shape in order to maneuver through the twisted pathway of the neurological and peripheral vascular system.

The examiner will try and clarify his rejections because the next couple of arguments by the applicant are erroneous and seem to diverge from the examiner's interpretation of the applicant's invention and the prior art. In claim 1, “the distal tip having a shapeable length that is shapeable by thermoforming techniques”, is being interpreted as a functional statement, with a product-by-process limitation. The functional statement is “shapeable”, which the examiner used MPEP section 2112, and

2114 to find the scope of the claim. The next limitation “by thermoforming techniques” is the process limitation, which results in the product being shapeable, which the examiner uses MPEP section 2112.01, 2112.02, and 2113 for his interpretation of the claim. The examiner would also like to note that thermoforming techniques is extremely broad, and since Samson et al. teaches the use of heat setting and using heat shrinking, that Samson et al. discloses this limitation (See Col. 6, lines 26-28, 30-28 and Col. 7, lines 1-8). The examiner further used case law to support his interpretation of the claims.

With regards to *In re Thorpe* the examiner used this case law to show that the patentability of the product (*the catheter*) does not depend on its method of production (*thermoforming techniques*) but on the finally product, and since the prior art reference and the claimed subject matter of this application are the same, the examiner has kept his rejection throughout prosecution. The examiner would also like to note that according to MPEP section 2112.01, “Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977)” and therefore, a prima facie position has been established.

The applicant's next argument is that the subject matter of claims 3 and 4 are not taught in the prior art reference. The examiner points to Column 6, lines 26-28, 30-31 and Column 7, lines 1-8 of the Samson et al. reference. The use of steam is once again a product by process limitation, since steam is the element that will heat set the distal

Art Unit: 3762

tip, and therefore does not have any structural relationship to the catheter. Therefore, the steam is an obvious and well-known method of heating shrinking tubes in the medical art. The structure of the claimed catheter is the same as the prior art and thus the prior art anticipates the claimed invention.

The examiner would also like to note that the claimed invention must be structurally distinguishable from the prior art in an apparatus claim as state in the MPEP section 2114 in order to receive a patent, and the examiner has not found any structure to be different then the catheter that is being claimed.

With regards to the last 103 Rejection of Samson et al. in view of Nita et al. is not well taken, because the applicant is arguing that Nita et al. does not teach “shapeable length shapeable by thermoforming techniques”, but this is not what Nita et al. is suppose to teach as recited in the 103 rejection in office action dated 1/28/04.

Since the applicant does not dispute the reasons to modify either prior art reference in the 103 Rejections, the examiner assumes that his reasons to modify are correct, and the only issue with the rejections is the interpretation of the phrase “shapeable length that is shapeable by thermoforming techniques,” The examiner would also like to add that Nita et al. discloses a catheter that is shapeable by thermoforming techniques because the catheter can be shaped and is formed by heat setting (Column 12, line 63 – Column 13, line 18; Column 16, lines 54-67 and example 2) techniques which are the same techniques that are used in the applicant’s invention.

For the above reasons, it is believed that the rejections should be sustained.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer, but there is a related copending US case presently under appeal within the same timeline as the present case.

Respectfully submitted,

Matthew DeSanto
April 15, 2008
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Primary Examiner, Art Unit 3763

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